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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,071	01/08/2002	Marc Michael Groz	MMG-002U	4941

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EXAMINER
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HOEL, MATTHEW D

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/043,071

Applicant(s)

GROZ, MARC MICHAEL

Examiner

Matthew D. Hoel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03/20/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-45 and 48 is/are rejected.
- 7) ☐ Claim(s) 46, 47 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 42 to 46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Adao e Silva (U.S. provisional application 60/254,053, published as WO 02/47010 A1, PCT/US0148587).
3. As to Claim 42: '053 teaches offering to sell tokens to a plurality of players to participate in a game (Page 2, Lines 13 to 17). Each of the tokens has a price and a designated residual value (Page 5, Lines 1 to 8; Page 3, Line 16 to Page 4, Line 3). '053 teaches receiving financial consideration from the players, the financial consideration being equal to the number of the tokens purchased by each of the players times the price of the tokens (50,000 shares, \$1,000 each, Page 5, Lines 1 to 8). '053 teaches allocating a first portion of the financial consideration to a prize pool, the first portion being greater than zero, and the prize pool to be distributed among the winners of the game (Page 5, Lines 9 to 11). '053 teaches conducting the game such that there is an outcome of the

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game wherein the outcome may comprise the designation of a portion of the tokens as winning tokens (Page 2, Lines 8 to 12). '053 teaches awarding the prize pool to the owners of the winning tokens if the outcome comprises the designation of winning tokens (Page 2, Lines 8 to 12). '053 teaches allocating a second portion of the financial consideration to purchase assets (Page 3, Lines 13 to 16). These assets have a positive expected return over a period of time such that the expected value of the assets at the end of the time period is greater than or equal to the financial consideration less the prize pool (funds, Page 4, Lines 4 to 13). '053 purchases the assets with the second portion of the financial consideration (Page 5, Lines 4 to 7). '053 teaches assigning the assets to the tokens (Page 5, Lines 1 to 8); the assignment to each token being in proportion to the price of each token times the residual value of each of the tokens (portion assigned to investment, Page 3, Line 17 to Page 4, Line 3). '053 commits to provide the current market value of the assets at the end of the period of time to the owners of the tokens (college investment fund eventually withdrawn, Page 4, Line 12).

4. As to Claim 43: The game of '053 can be a lottery (Page 2, Line 14).
5. As to Claim 44: An electronic receipt is inherent in the Internet gaming site of '053 (Page 3, Lines 6 to 9).
6. As to Claim 45: The residual value of '053 can be 50% (Page 3, Line 20 to Page 4, Line 1).
7. As to Claim 48: The residual value of '053 can be less than or equal to 80% (Page 3, Line 20 to Page 4, Line 1).

***Allowable Subject Matter***

8. Claims 46, 47, and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not indicate a state-run lottery being used in conjunction with the present invention as in Claim 46, a greater return than a conservative investment as in Claim 47, or a bank account used in conjunction with the present invention as in Claim 49.

***Response to Arguments***

9. The affidavit by Tom Bakos of Mar. 17<sup>th</sup>, 2006 is entered. Mr. Bakos states that one of ordinary skill in the art would understand the terms "current market value" and "cash value" to mean the same thing. This overcomes the rejections to Claims 42 to 49 in view of Nilssen ('275), Grippo ('032), and Ridge, et al. ("Bonus Bonds"). The amendment to Claim 42 is entered to clarify part h). The examiner admits no error as the previous rejection was made in good faith. The examiner believed that one of ordinary skill in the art might reasonably construe "cash value" to mean either the value of the underlying assets at the time they were purchased ("Bonus Bonds," Page 74, Para. 5) or the value of the those assets at the time they were redeemed. The examiner takes the affidavit at face value and withdraws those rejections. Mr. Bakos is a certified actuary

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and appears to be one of ordinary skill in the art. Mr. Nowotarski previously indicated that applicant Mr. Groz kept good records and would be able to swear behind the '053 reference, which was filed about one month before the present application. Doing so would place the claims in condition for allowance.

### ***Specification***

10. The abstract of the disclosure is objected to because the abstract does not reflect the currently claimed subject matter. Correction is required. See MPEP § 608.01(b).

11. Applicant is reminded of the proper content of an abstract of the disclosure.

12. A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

13. The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

14. Where applicable, the abstract should include the following:

- 15. if a machine or apparatus, its organization and operation;
- 16. if an article, its method of making;
- 17. if a chemical compound, its identity and use;
- 18. if a mixture, its ingredients;
- 19. if a process, the steps.

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20. Extensive mechanical and design details of apparatus should not be given.

***Citation of Pertinent Prior Art***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Journal of Financial Economics article "The Case of the Swedish Lottery Bonds," by Green and Rydquist, vol. 53, no. 2, 1999, pp. 145-187, is considered relevant. The results of the Science and Technical Center search for this case, 10/043,071, are considered relevant. The WIPO publication WO 02/47010 A1, PCT/US01/48587, is considered relevant.

***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew D. Hoel, Patent Examiner  
AU 3713

  
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TC3700